

Status of Claims

Claims 1-30 are pending of which claims 1, 20-22, and 26-29 are independent.

Claims 18, 19, 24, 25 and 30 are withdrawn.

Claims 1-10, 12-17, 20, 22, 23 and 26 are rejected.

Claims 1, 20-22 and 26 are amended.

The rejections of claims 11, 21, and 27-29 were withdrawn in the Examiner's Answer.

Summary of Rejections

Claims 1-10, 12-17, 22, and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wiser (6,385,596) in view of Parenty (2002/0064283).

Claims 20 and 26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wiser in view of Parenty in further view of Katayama (2002/0027994).

Summary of Status of Claims per Board Decision and Examiner's Answer

The rejections cited above were affirmed by the Board Decision dated September 21, 2011. The rejections of claims 11, 21, and 27-29 were withdrawn in the Examiner's Answer and thus were not considered by the Board. These claims are considered to include allowable subject matter since they are not rejected.

Rejection of Claims 1-10, 12-17, 22, and 23 under 35 U.S.C. §103(a) as being unpatentable over Wiser in view of Parenty

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in *KSR International Co. v. Teleflex Inc.*, 550 U.S._, 82 USPQ2d 1385 (2007):

“Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” Quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966).

According to the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, Federal Register, Vol. 72, No. 195, 57526, 57529 (October 10, 2007), once the *Graham* factual inquiries are resolved, there must be a determination of whether the claimed invention would have been obvious to one of ordinary skill in the art based on any one of the following proper rationales:

(A) Combining prior art elements according to known methods to yield predictable results; (B) Simple substitution of one known element for another to obtain predictable results; (C) Use of known technique to improve similar devices (methods, or products) in the same way; (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; (E) ‘‘Obvious to try’’—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success; (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference

teachings to arrive at the claimed invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S._, 82 USPQ2d 1385 (2007).

Furthermore, as set forth in *KSR International Co. v. Teleflex Inc.*, quoting from *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006), “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasonings with some rational underpinning to support the legal conclusion of obviousness.”

Furthermore, as set forth in MPEP 2143.03, to ascertain the differences between the prior art and the claims at issue, “[a]ll claim limitations must be considered” because “all words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385.

If the above-identified criteria and rationales are not met, then the cited references fail to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited references.

1. Claims 1-10, 12-17, 22 and 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Wiser in view of Parenty.

Claim 1 has been amended to recite,

receiving at a content server via an insecure communications channel at least one shared secret from a device, wherein the at least one shared secret is received in encoded form that functions as an identifier of the device...

receiving at the content server the shared secret in plaintext form via a secure communications channel.

Independent claim 22 has been amended to recite,

a computer to receive a shared secret in an encoded form from a device, the encoded shared secret functioning as a device identifier;...

the computer to receive the shared secret in plaintext form via a secure channel.

Support for these features is at least provided on pages 9 and 10 of the Applicants' specification.

Wiser in view of Parenty fails to teach or suggest receiving a shared secret twice at the same computer, and the share secret is received in two forms, *i.e.*, an encoded form and a plaintext form. According to the rejection, the shared secret is received once in encrypted form by the media licensing center in Wiser. However, neither Wiser nor Parenty singly or in combination teach or suggest a media licensing center receiving the credit card information twice, but in two different forms. Furthermore, there would be no need for the media licensing center in Wiser to receive the credit card information twice, because once it is received, the transaction can be completed.

In the Board Decision on page 7, the Board stated the "receiving the shared secret in a plaintext form" does not recite which device receives the shared secret. The Board found that Wiser discloses the media licensing center receives credit card information and then forwards the credit number to the payment center. The Board essentially concluded that because claim 1 does not recite which device receives the shared secret, Wiser's disclosure of two different devices receiving credit card information teaches the claimed feature. However, as indicated above, claims 1 and 22 have been amended to recite the same computer/content server receives the shared secret twice in two forms. Accordingly, Wiser in view of Parenty fails to teach or suggest

the features of claims 1 and 22 recited above, and claims 1-10, 12-17, 22 and 23 are believed to be allowable.

2. Claims 20 and 26 are rejected under 35 U.S.C. §103(a) as being unpatentable over Wiser in view of Parenty in further view of Katayama.

Independent claim 20 has been amended to recite, “sending the shared secret to a content server in the plaintext form, wherein the content server previously received the shared secret in encoded form.” Independent claims 26 recites similar features.

As indicated above, Wiser in view of Parenty fails to teach or suggest receiving a shared secret twice at the same computer. Katayama was cited as allegedly disclosing in paragraphs 64 and 78 that a content key is sent to the user after the encrypted content is downloaded and in response to the purchase order for the content key. Katayama, however, also fails to teach or suggest receiving a shared secret twice at the same computer, and in two forms. Thus, claims 20 and 26 are also believed to be allowable.

PATENT

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Conclusion

For at least the reasons given above, claims 1-17, 20-23, 26-29 are believed to be allowable.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the above-identified application, please contact the undersigned at the telephone number listed below.

Please grant any required extensions of time and charge any fees due in connection with this Appeal Brief to deposit account no. 08-2025.

Respectfully submitted,

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